

REMARKS

This amendment is accompanied by a Request for Continued Examination and is submitted in response to the outstanding final Office Action mailed August 13, 2009. Claims 75, 78, 80, 99, 102 and 104 are amended to replace “dependents” with “recipients” and “son or daughter” with “third party recipient.” Support for these amendments is found in the originally-filed specification at, for example, page 5, lines 3-5.

Claims 111-113 are new. Support for claims 111 and 112 is found in the originally-filed specification at, for example, page 18, line 15 to page 19, line 17, wherein use of an internet network is implicitly disclosed in a description of banking from home. Use of an internet network is also described at page 15, lines 15-18 wherein transmission of information by e-mail is disclosed. Support for claim 113 is found, for example, at page 15, lines 3-19. The addition of new claims 111-113 and the amendments to claims 75, 78, 80, 99, 102 and 104 therefore do not introduce new matter.

Accordingly, in view of the following remarks, reconsideration by the Examiner and allowance of this application is respectfully requested.

Turning to the Office Action, claim 98 was rejected under 35 U.S.C. §101, because the claimed invention was allegedly directed to non-statutory subject matter. Specifically, the Examiner alleges that the process steps in claim 98 are not tied to another statutory class nor do they execute a transformation. This rejection is respectfully traversed for the following reasons.

Without conceding the correctness of the Examiner’s position, Claim 98 has been cancelled to expedite prosecution of the present application. Applicants cancel this claim without prejudice and reserve the right to file a Continuation Application on the cancelled subject matter.

By cancelling Claim 98, however, this rejection under 35 U.S.C. §101 has thus been overcome. Reconsideration by the Examiner and withdrawal of the rejection is respectfully requested.

Next, Claims 75, 77– 85, 87, 99, 101 – 108, and 110 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states that Applicant discloses an “external bank, credit card or atm network,” yet neither the original specification nor claims disclose that the fund depositor account and the third party account communicate with each other through such a network. This rejection is respectfully traversed for the reasons set forth hereinafter.

The specification discloses at page 16, lines 3 – 5 that the method can be implemented through a bank teller or bank ATM machine (“it is more economical for a bank to permit a third party recipient to access cash via an ATM, rather than require the recipient to present themselves to a bank teller.”). The use of banking ATM networks (which are also credit card networks) to withdraw cash or purchase goods or services is disclosed throughout the specification. See, for example, the last paragraph of page 20 as just one example:

The third party recipient then uses the card like any other ATM or debit card to obtain cash from ATM machines, unless this feature has been blocked, and to obtain goods and services from merchants and service providers. And like any other ATM or debit card transaction, each requested transaction is submitted to the bank’s data processing system for approval.

Additionally, page 22, lines 15 – 19 discloses:

The system of the present invention is also extremely versatile because of its ready adaptability to existing banking networks. Such networks make it possible to set aside funds in a distant city for a third party recipient without regard for whether the bank of the account holder has branches in that city,

which implicitly requires and contemplates the fund depositor account and the third party account communicating through a banking ATM/credit card network.

MPEP §2163.02 states that, “to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is

now claimed.” The afore-cited passages from the specification demonstrate that applicant was in possession of having fund depositor account and the third party account communicate through an external bank, credit card or ATM network at least as early as the April 16, 1996 filing date of U.S. Patent Application Ser. No. 08/585,173. Accordingly, reconsideration by the Examiner and withdrawal of this rejection is respectfully requested.

Finally, Claims 75, 77– 85, 87– 88, 90– 96, 98– 99, 101–108 and 110 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over Nakano et al., U.S. Pat. 5,845,260 in view of Anderson et al., U.S. Pat. No. 5,706,442 and Dorrough et al., U.S. Pat. No. 5,287,269. Nakano et al. was cited by the Examiner as disclosing using information entered by a depositor on a PC to create a third party account, periodically and automatically transferring money into the account, and limiting the funds spent and how the funds are spent. The Examiner considers in implicit from Nakano et al. that a bank or other financial institution will verify that there are sufficient funds in an account to support a funds transfer.

The Examiner acknowledges that Nakano et al. do not teach the fund depositor viewing the account activity through a CRT or LCD device, but cites Anderson et al. as disclosing this. The Examiner also acknowledges that neither Nakano et al. or Anderson et al. describe issuing an encoded card such as a debit card to a child, but cites Dorrough et al. as disclosing this. Finally, the Examiner states that it has been taken as admitted prior art that a well known method for exchanging data over the internet is via electronic mail.

This rejection is respectfully traversed for the reasons set forth hereinafter.

Nakano et al. describes a closed system that is not implemented through an external bank, credit card or atm network. The creation of an imaginary account is described in which a child has “a quasi-experience of a business transaction extremely similar to a real one.” (Col. 7, lines 1 – 2. The child receives credits, which can be allocated as an allowance, that can be used to

purchase goods and services through a cable network service provider. Unlike the present invention the child cannot make purchases outside the closed network, let alone outside the home.

The Examiner incorrectly assumes that Nakano et al. use a bank or other financial institution to verify that there are sufficient funds in an account to support a funds transfer. This is handled by the cable network service provider. No funds are ever transferred from parent to child and therefore are never used by the child to purchase goods or services over the cable network. The child instead receives imaginary credits that are used to purchase goods and services for which the parent is later billed on their credit card. The use of imaginary credit calls into question whether what is claimed by Nakano et al. is even statutory subject matter under 35 U.S.C. §101.

Nakano et al. therefore fails to teach or suggest the presently claimed method that is implemented through an external bank, credit card or ATM network to transfer actual funds to a third party recipient to withdraw cash or purchase goods and services from network vendors, even in distant cities. There is also no motivation in Nakano et al. to modify the process therein to arrive at the presently claimed invention. The objective of Nakano et al. is to provide a system in which it is not necessary to issue a child a card in communication with an external bank, credit card or ATM network. (See col. 7, lines 43 – 50.)

Nakano et al. therefore teach against the presently-claimed invention on several levels. First, Nakano et al. teach against permitting the fund recipient to transact business over an external bank, credit card or ATM network. Second, Nakano et al. teach against internet transactions to the extent they would involve the transfer of funds over an open network. Thus while Anderson et al. may teach the exchange of financial information over the internet, Nakano et al. teaches against the use of such an open network, and, in any event, Anderson et al. does not teach, suggest or motivate one of ordinary skill in the art to establish a system where transaction information is transmitted over a computer network to inform a fund depositor how the third

party he or she provided money to spent the funds. This cannot be learned by reading Nakano et al. or Anderson et al., alone or in combination.

While Dorrough et al. may teach an encoded magnetic card, the card is also used within a closed system rather than an open bank, credit card or ATM network. There is no teaching, suggestion or motivation to apply it externally. Instead, as previously noted, Nakano et al. teach against doing this.

At best, the cited combination of prior art teach a closed system through which parents may allot the amount a child spends over a period of time over a closed network, be it the recreational facility of Dorrough et al. or the cable network of Nakano et al. There is no teaching, suggestion or motivation to establish the present system where limits on goods or services that may be purchased may be established using the existing vendor identification system of a banking, credit card or ATM network (see page 5, last paragraph or the present specification). To the contrary, Nakano et al. teach that this is not possible! (See Col. 7, lines 43–45.)

To accomplish what a primary reference teaches cannot be done patentably defines there-over. What the secondary references teach becomes immaterial, because such a teaching in the primary reference mitigates the secondary teachings.

Given the ability of the present invention to do what Nakano et al. teaches cannot be done, the presently claimed invention patentably defines over the cited prior art viewed alone or in combination. In view of the foregoing remarks, this rejection of Claims 75, 77–85, 87–88, 90–96, 98–99, 101–108 and 110 under 35 U.S.C. §103(a) as being unpatentable for obviousness over Nakano et al., U.S. Pat. 5,845,260 in view of Anderson et al., U.S. Pat. No. 5,706,442 and Dorrough et al., U.S. Pat. No. 5,287,269 has thus been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Applicant(s): Picciallo
Application No.: 09/478,051

Docket No. 73348.00008 (P22,425-B USA)

In view of the above claim cancellations and foregoing remarks, this application is now in condition for allowance. Reconsideration is respectfully requested. The Examiner is requested to telephone the undersigned to discuss any remaining issues in this application to be resolved.

Finally, the Examiner is authorized to charge applicant's Deposit Account No. 50-1943 for any additional charges in connection with this Amendment.

Respectfully submitted,

/Peter J. Butch III/
PETER J. BUTCH, III
Reg. No. 32,203

Fox Rothschild LLP
997 Lenox Dr. Bldg. 3
Lawrenceville, NJ 08648
Telephone: 609-844-3035
Facsimile: 609-896-1469